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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,039	09/28/2001	Carolyn McNee	13845.1US01	4847
23552	7590	01/09/2006		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/967,039

Applicant(s)

MCNEE ET AL.

Examiner

Sara Chandler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/26/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

There is a non-initialed alteration made on the last page of the oath or declaration dated February 26, 2002. See 37 CFR 1.52(c).

***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "comprising" should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The abstract of the disclosure is objected to because it contains legal phraseology such as "comprises". Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1,5,7-9, 13,15-17 and 19,22,24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hovakimian, U.S. Patent No. 5,466,919, in view of McCarthy, U.S. Patent No. 5,287,268.

**Re Claim 1:** Hovakimian discloses a method allowing a credit cardholder to make a charity donation whenever he makes a purchase using the credit card (See abstract) comprising: (a) associating a member shopper identifier (e.g., credit/charge card) with a member shopper profile including at least one selected charity (See column 1, lines 33-37; column 1, lines 60-64); and (b) transferring a donation amount to at least one selected charity (See column 2, lines 12-15).

Hovakimian fails to disclose a method comprising: (a) receiving a contribution request from a member merchant that is responsive to a purchase made by the member shopper that comprises a member shopper identifier, a member merchant identifier, and a purchase amount (b) associating the member merchant identifier with the member merchant profile; and the inclusion of contribution instructions in the member merchant profile (c) storing data related to the purchase in the shopper profile associated with the member shopper (d) determining the donation amount at least in part by the purchase

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amount and merchant contribution instructions and (e) generating a recruiting merchant report that includes information about the purchases made by the member shopper.

McCarthy discloses a method which allows shoppers to accumulate cash value based upon purchases made with multiple merchants and the method does not rely on the use of a credit/charge card as the member shopper identifier (See abstract).

McCarthy discloses a method comprising: (a) receiving a contribution request (e.g., output to the central system via the I/O device and communication line) that is responsive to a purchase made by the member shopper that comprises a member shopper identifier (e.g., consumer account, birthdate), a member merchant identifier, and a purchase amount (e.g., credit value for the transaction based upon the transaction data and credit rate) (See column 3, lines 50-58) (b) associating the member merchant identifier with the merchant profile; and the inclusion of contribution instructions in the merchant profile (e.g., there is a description of merchant data including a merchant code number to identify the merchant and a credit rate selected by the merchant for which cash value can be accumulated for purchases from that merchant) (See column 3, lines 33-35 and 40-45) (c) storing data related to the purchase in the shopper profile associated with the member shopper (See column 3, lines 29-31) (d) accumulating cash value on the shopper's behalf with the cash value determined at least in part by the purchase amount (e.g., transaction data) and merchant contribution instructions (e.g., merchant selected credit rate) (See abstract; column 3, lines 50-53).

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It would have been obvious to one of ordinary skill in the art to modify Hovakimian to include the teachings of McCarthy to expand charitable donations at the time of purchase to non-credit transactions for the purpose of allowing more member shoppers to participate in the charitable donation program.

1(f) The combination of Hovakimian and McCarthy does not explicitly disclose the generation of a recruiting merchant report that includes information about the purchases made by the member shopper. McCarthy does disclose how, "additional merchant data segments may be included to provide a listing of transactions for each merchant" (See column 4, lines 54-57). The additional data segments may be used for the generation of a recruiting merchant report. It would have been obvious to one of ordinary skill in the art to generate a merchant report because it is common practice in business to evaluate transaction data and generate reports for purposes such as consumer marketing or auditing.

**Re Claim 5:** Hovakimian discloses a method for charitable donations (See abstract), but fails to disclose a method where member merchants can receive an invoice of the donations made on the member shoppers' behalf. McCarthy discloses a method comprising invoicing the member merchant (e.g., bill), with the invoice corresponding to the monetary amount accumulated on the member shoppers' behalf (See abstract; See column 5, line 52-54). It would have been obvious to one of ordinary skill in the art to provide member merchants with an invoice of donations made to charities on the member shoppers behalf by applying the invoicing technique described in McCarthy to Hovakimian because it is common practice in business to

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keep a record of funds received and their source for purposes such as taxation and it is common practice to provide invoices for record keeping purposes.

**Re Claim 7:** Hovakimian, discloses a method comprising the member shopper identifier (e.g., credit/charge card): (a) stored on a magnetic strip that has encoded the shopper's profile (e.g., encoded account identification) and at least one charity previously selected by the member shopper (e.g., encoded alpha numeric data indicating a selected charity to receive a donation) (See column 2, lines 31-36) (b) readable by a scanner at the member merchant (e.g., The data may be placed at any location along the strip determined as convenient for the card reader equipment) (See column 2, lines 38-40) and (c) the language of Hovakimian can also be interpreted to include the electronic transmission to the database of the information held on the magnetic strip (See Column 3, lines 5-11). Hovakimian fails to disclose a method comprising a member shopper identifier stored on the magnetic strip of a membership card rather than a credit/charge card. McCarthy discloses a method comprising a member shopper identifier: (a) linked to a shopper profile other than a credit card account number (See abstract) and (b) where information can be stored on the magnetic strip of a membership card (See column 1, lines 59-61). It would have been obvious to one of ordinary skill in the art to adopt the method for having the member shopper identifier stored on the magnetic strip of a membership card for the purpose of making the charitable donation process accessible to member shoppers that were not credit/charge card holders.

**Re Claim 16:** Hovakimian discloses a method comprising: (a) a credit cardholder making a donation to a target (e.g., charity) whenever he makes a purchase using the credit card (b) associating the member shopper identifier (e.g., credit/charge card) with a member shopper profile including at least one target (e.g., charity) (See column 1, 33-37; Figure 2) (c) a transaction processing method that enables the transfer of a contribution amount to the selected target (e.g., charity) (See column 2, lines 12-15). Hovakimian fails to disclose a method comprising (a) receiving a contribution request from a merchant that is responsive to a purchase made by the member shopper that comprises a member shopper identifier, a member merchant identifier, and a purchase amount (b) associating the merchant identifier and the merchant profile and the inclusion of contribution instructions in the merchant profile (c) storing data related to the purchase in the shopper profile associated with the member shopper and (d) how the contribution amount is determined at least in part by the purchase amount and merchant contribution instructions.

McCarthy discloses a method in which member shoppers accumulate cash value based upon purchases made with multiple merchants and the method does not rely on a credit/charge card as the member shopper identifier (See abstract). McCarthy discloses a method comprising: (a) receiving a contribution request (e.g., output to the central system via the I/O device and communication line) that is responsive to a purchase made by the member shopper that comprises a member shopper identifier (e.g., consumer account, birthdate), a member merchant identifier, and a purchase amount (e.g., credit value for the transaction based upon the transaction data and credit



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rate) (See column 3, lines 50-58) (b) associating the merchant identifier with a merchant profile and the inclusion of contribution instructions in the merchant profile (e.g., there is a description of merchant data including a merchant code number to identify the merchant and a credit rate selected by the merchant for which cash value can be accumulated for purchases from that merchant) (See column 3, lines 33-35 and 40-45) (c) storing data related to the purchase in the shopper profile associated with the member shopper (See column 3, lines 29-31) and (d) shoppers accumulating cash value, the amount determined at least in part by the purchase amount (e.g., transaction data) and merchant contribution instructions (e.g., merchant selected credit rate) (See abstract; column 3, lines 50-53).

It would have been obvious to one of ordinary skill in the art to modify Hovakimian to include the teachings of McCarthy for the purpose of enabling contributions to the target of the member shoppers' choice because it would create an incentive for member shoppers' to purchase from member merchants.

**Re Claim 17:** Hovakimian discloses a method allowing a credit cardholder to make a charity donation whenever he makes a purchase using the credit card (See abstract). Hovakimian fails to disclose a method of charity donation that does not rely on the use of a credit/charge card as the member shopper identifier (See abstract). McCarthy discloses a method comprising shoppers accumulating cash value based upon purchases made with multiple merchants regardless of mode of payment (See abstract). It would have been obvious to one of ordinary skill in the art to combine Hovakimian and McCarthy because charitable donations would create an incentive for

member shoppers to purchase from member merchants; and more member shoppers could participate if the mode of payment did not matter.

**Claims 8 ,9 and 19** contain features or limitations recited in Claim 1, therefore they are rejected under the same rationale.

**Claims 13,15, 22 and 24** contains features or limitations recited in Claims 5 and 7, respectively, therefore they are rejected under the same rationale.

**Claims 2-3, 6, 10-11,14, 20-21 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hovakimian, U.S. Patent No. 5,466,919, in view of McCarthy, U.S. Patent No. 5,287,268 as applied to claims 1,5,9,13,17 and 22 above, and further in view of Massey, (WO 00/20984).

**Re Claim 2:** Hovakimian discloses a method comprising generating a member shopper report, the report including information about donations made to at least one selected charity when the donations are made by credit/charge cardholders (See column 3, lines 49-53). Hovakimian fails to disclose a method comprising generating a member shopper report including information about donations made to at least one selected charity when the transaction did not involve a credit/charge card. McCarthy discloses a method comprising (a) the accumulation of cash value for transactions using a member shopper identifier other than a credit/charge card (See abstract) and (b) how to store data regarding the member shopper and the purchase (See column 3, lines 29-31). McCarthy fails to disclose a method comprising the generation of a member shopper report, the report including information about donations made to at least one selected charity. Massey discloses a method comprising generating a

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member shopper report for the member shopper, the report including information about donations made to at least one selected charity (See page 8, lines 10-13; page 9, line 21-22; page 12, lines 1-5; page 17 lines 7-10; and page 19; lines 2-4) It would have been obvious to one of ordinary skill in the art to modify Hovakimian to include the teachings of McCarthy and Massey for the purpose of generating a report for member shoppers that includes information about donations made to at least one charity because as Massey suggests the member shopper report could be used as a record of spending or for tax purposes.

**Re Claim 3:** Hovakimian discloses a method comprising generating a report for credit/charge cardholders which includes information about donations made to at least one selected charity (See column 3, lines 49-53). Hovakimian fails to disclose a method comprising generating a report for the selected charities regarding the member shoppers and member merchants that made the donations. McCarthy discloses a method comprising (a) member shoppers accumulating cash value for transactions using a member shopper identifier other than a credit card (See abstract) and (b) storage of data regarding the member shopper, the member merchant and the purchase (See column 3, lines 29-33). McCarthy fails to disclose a method comprising generating a report for the selected charities. Massey discloses a method comprising generating a charity report for each selected charity (See page 9, lines 21-22; page 12, lines 2-5). It would have been obvious to one of ordinary skill in the art to generate a report for a third party (e.g., selected charity) regarding any information for which data was obtained such as the member shoppers, member merchants and their purchases

(e.g., a charitable donation) because businesses frequently generate reports for third parties such as shareholders, the media or consultants for purposes such as improving public image or business practices.

**Re Claim 6:** Hovakimian discloses a method for charitable donations (See abstract), but fails to disclose a method comprising: (a) invoicing the member merchant for the donation amount and (b) generating a member merchant report to the member merchant that includes information about the amount donated by the member merchant. McCarthy discloses a method comprising a member merchant receiving an invoice (e.g., bill) corresponding to the monetary amount accumulated on the member shoppers' behalf (See abstract; See column 5, line 52-54), but fails to disclose a method comprising generating a member merchant report to the member merchant that includes information about the amount donated by the member merchant. Massey discloses a method comprising generating a member merchant report to the member merchant that includes information about the amount donated by the member merchant (See page 9, lines 21-22; page 12, lines 2-5). The language of Massey is interpreted broadly, and the reference to generating a report of "relevant information" is considered to include information about the amount of the member merchant's donations (See page 12, lines 13-4). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hovakimian, McCarthy and Massey for the purpose of generating a member merchant report about the member merchants donations because as Massey suggests these reports may be used for purposes such as evaluating targeted promotions and consumer goodwill.

**Claims 10-11,14, 20-21 and 23** contains features or limitations recited in Claims 2,3 and 6, respectively, therefore they are rejected under the same rationale.

**Claims 4, 12 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hovakimian, U.S. Patent No. 5,466,919 in view of McCarthy, U.S. Patent No. 5,287,268 as applied to Claims 1,9 and 16 above, and further in view of Kalina, U.S. Patent No. 5,970,480. Hovakimian and McCarthy fail to disclose the transfer of a monetary amount into a retirement savings plan; and that the transfer amount is based at least in part on the purchase amount and the merchant contribution instructions. Kalina discloses a method where a monetary amount (e.g., credit award) is transferred to an investment vehicle on behalf of the member shopper (See abstract; column 4, line 67 – column 5, line 2). From the language of Kalina, the term “investment vehicle” is read broadly to include several forms of investment including a retirement savings plan. Kalina further discloses that the monetary amount (e.g., credit award) transferred is determined by the purchase amount of the transaction and the merchant contribution instructions (e.g. credit award agreement contracts) (See Abstract). It would have been obvious to one of ordinary skill in the art to combine the method of transferring money on behalf of a member shopper to an investment vehicle (i.e., retirement savings account) disclosed in Kalina with the methods of charitable donations and cash value accumulation previously disclosed in Hovakimian and McCarthy, respectively, for the purpose of creating another incentive for member shoppers to purchase from a member merchant.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMC



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